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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,330

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EXAMINER

SPECTOR, DAVID N

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,330

Applicant(s)

BUSSCHER ET AL.

Examiner

David N. Spector

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: DETAILED ACTION.

DETAILED ACTION

Status of the Application

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn; moreover:

(a) Applicant's arguments (*see Page 8, Line 6 through Page 9, Line 2*) filed 9/21/2004, with respect to the rejection of claims 2-9 and 14-36 under U.S.C. 35 §112, first paragraph, have been fully considered and are persuasive. Therefore, the rejection of claims 2-9 and 14-36 under U.S.C. 35 §112, first paragraph, has been withdrawn.

(b) Applicant's arguments (*see Page 9, Lines 3-12*) filed 9/21/2004, with respect to the rejection of claim 11 under U.S.C. 35 §112, second paragraph, have been fully considered and are persuasive. Therefore, the rejection of claim 11 under U.S.C. 35 §112, second paragraph, has been withdrawn.

(c) Applicant's arguments (*see Page 9, Lines 13-18*) and amendments (*see Page 4, Line 17-25; Page 5, Lines 10-19*) filed 9/21/2004, with respect to the rejection of claims 19-28 under U.S.C. 35 §112, second paragraph, have been fully considered and are persuasive. Therefore, the rejection of claims 19-28 under U.S.C. 35 §112, second paragraph, is now moot, and has been withdrawn.

(d) Applicant's arguments (*see Page 9, Lines 19-29*) filed 9/21/2004, with respect to the rejection of claims 2-5, 7-10, 12-14, 29-32, and 34-36 under U.S.C. 35 §102(b) as being anticipated by Bulgajewski et al. (U.S. Patent No. 6,426,485) have been fully considered and are persuasive. Therefore, the rejection of claims 2-5, 7-10, 12-14, 29-32, and 34-36 under U.S.C. 35 §102(b) has been withdrawn.

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2. Claims 2-36 are now pending in the application. New ground(s) for the objection to and/or the rejection of applicants claims, and/or other aspects of the instant application are raised/made in the following sections of this Office action.

Specification - Objections

3. **The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.** See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the material extant in the present specification (Page 20, Line 11-Page 21, Line 3) relevant to the invention(s) currently claimed in the instant application (*e.g. deemed to be apparatus/methods incorporating diffusers in light-generating devices for the display of turn-signal indicators in/on an exterior rear-view mirror*) is expressed in terms which are not consistent with the many of the features/limitations which are currently recited in claims. In particular, many of the features/limitations of the claimed invention(s) are recited in terms of a "member" (*inter alia*, Claim 2, Lines 3 and 5; Claim 10, Lines 2 and 3; Claim 14, Lines 4, 5 and 7; Claim 19, Lines 4, 5, 7, and 9; Claim 24, Lines 4, 5, 6, 7, 9, and 10); whereas the word "member" does not appear anywhere in the instant specification (or anywhere in the parent application for the current case (*e.g. ASN 09/862,414; filed 5/21/2001; now U.S. Patent No. 6,650,457*)).

Drawings - Objections

4. **The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims:**

(a) the three different diffuser arrangements (*e.g. "diffuser directly applied to the area"; light-diffusing panel placed over the area"; and "diffuser applied to the surface of the member in the area"* variously recited in claims 2, 5-7, 11, 12, 15-17, 19-22, 24-27, and 32-34 must be shown or the feature(s) canceled from the claim(s).

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(b) the "member" recited throughout many of applicants' claims (*e.g. inter alia, as noted above, in the preceding paragraph of this action*) must clearly be shown and identified in the drawings, or the feature(s) canceled from the claim(s). No new matter should be entered.

5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 19-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More specifically,

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the "conductive layer" recited in each of the independent claims 19 and 24 (Claim 19, Line 7; Claim 24, Line 6) does not appear anywhere in the instant specification. Similarly, the aforesaid conductive layer does not appear anywhere in the parent application for the instant case (Serial No. 09/862,414; filed 5/21/2001; now U.S. Patent No. 6,650,457). Claims 19-28 therefore fail to comply with the enablement requirement.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 2-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** The incessant use of a particular feature/limitation vaguely recited as "a member" and/or "the member" in applicants' independent claims 2, 10, 14, 19 and 24 renders claims 2-28 indefinite because it is unclear as to which of the plurality of the extant generally recognized definition(s) "member" corresponds to the intended meaning of the word/term as used therein (*e.g. in particular, meaning "a distinct part of a whole", or alternatively, as being "a structural unit"*). It is noted, above in the present Office action, that the word "member" does not appear anywhere in the current specification, or anywhere in the parent application for the current case. As a result, the situation with respect to the interpretation of applicants present independent claims 2, 10, 14, 19 and 24 is exacerbated to the degree that examiner can not clearly identify the actual feature/limitation corresponding to said member in the current drawings. Correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

FOR EXAMINATION ONLY: In the rejections which follow, the word/term member is broadly interpreted as "a distinct part of a whole".

11. Claims 2, 10, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Crandall (U.S. Patent No 5,436,741).

(a) In regard to independent claim 2, Crandall discloses (col. 2, ln. 16-col. 3, ln. 64; **FIG. 4-7**) an exterior rearview mirror assembly **10** comprising: a mirror element **34** having a front surface and a rear surface (e.g. the front/rear surfaces of mirror element **34** can clearly be seen in **FIG. 6**), the mirror element **34** having a portion allowing light to pass therethrough (col. 2, ln. 59-col. 3, ln. 5); a member **20** located adjacent the rear surface of the mirror element (col. 2, ln. 29-33, 58-59), the member **20** including an area **22** aligned with the portion of the mirror element (col. 2, ln. 33-37); and a light source **26** emitting light, the light being directed at the area **22**; the area **22** of the member **20** and the portion of the mirror element **34** allowing light from the light source **26** to pass therethrough, wherein the area includes a diffuser **38** (col. 3, ln. 6-10) to diffuse light passing through the element **34** (col. 3, ln. 55-56). Claim 2 is therefore anticipated by Crandall.

(b) In regard to independent claim 10, Crandall discloses (col. 2, ln. 16-col. 3, ln. 64; **FIG. 4-7**) an exterior rearview mirror assembly which implicitly, and by example, teaches method of assembling an exterior rearview mirror assembly comprising: [a step for] providing a member **20** having an area **22** adapted to allow light to pass therethrough; and treating the area of the member **22** to diffuse the light passing through the member **20** (col. 3, ln. 6-9). Claim 10 is therefore anticipated by Crandall.

(c) In regard to independent claim 14, Crandall discloses (col. 2, ln. 16-col. 3, ln. 64; **FIG. 4-7**) an apparatus for an exterior vehicle mirror assembly including a reflective element **34** having

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inner and outer surfaces (e.g. the inner/outer surfaces of mirror element **34** can clearly be seen in **FIG. 6**) and a light source **26** positioned to direct light toward the inner surface of the reflective element **34**, the apparatus comprising: a member **20** extending between the inner surface of the reflective element **34** and the light source **26** (col. 2, ln. 29-33, 58-59), the member **20** including an area **22** adapted to allow light from the light source **26** to pass therethrough (col. 2, ln. 59-col. 3, ln. 5); and a light diffuser (col. 3, ln. 6-10) positioned over the area **22** of the member **20** to diffuse light passing through the element **34** (col. 3, ln. 55-56). Claim 14 is therefore anticipated by Bulgajewski et al.

12. **Claim 4 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Faloon et al. (U.S. Patent No 5,587,699).** Faloon et al. discloses (col. 2, ln. 65-col. 5, ln. 15; **FIG. 1A/1B, FIG. 2**) all of the features/limitations for an exterior rearview mirror assembly **10**, commensurate with independent claim 2 from which claim 4 depends, comprising: a mirror element **16** having a front surface **18** and a rear surface **20** (col. 3, ln. 16-20), the mirror element **16** having a portion **24** allowing light to pass therethrough (col. 3, ln. 44-56); a member **32/34/36** located adjacent the rear surface **20** of the mirror element **16**, the member **32/34/36** including an area **32** aligned with the portion **24** of the mirror element **16** (col. 2, ln. 33-37); and a light source **36** emitting light, the light being directed at the area **32**; the area **32** of the member **32/34/36** and the portion **24** of the mirror element **16** allowing light from the light source **36** to pass therethrough, wherein the area includes a diffuser **34** to diffuse light passing through the element **16**. Furthermore, Faloon et al. discloses that light source **36** includes light emitting diodes (col. 4, ln. 17-21). Claim 4 is therefore clearly anticipated by Faloon et al.

Other Remarks/Information

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. A number of applicants' claims would also appear to be either anticipated by, or un-

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patentable over Crandall (U.S. Patent No. 5,938,320) and/or Gray et al. (U.S. Patent No. 5,313,335).

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

15. Any other inquiry concerning this communication or earlier communications from the examiner should be directed to David N. Spector whose telephone number is (571) 272-2338. The examiner can normally be reached at this number Monday through Friday between 6:00 AM and 2:30 PM. The fax number for the organization where this application is assigned is (703) 872-9306.

October 6, 2004

A handwritten signature in black ink, appearing to read 'D. N. Spector', with a long horizontal line extending to the right.

DAVID N. SPECTOR
PRIMARY EXAMINER